



SEP 5 2001

In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 C.F.R. § 10.7(c)  
:

### **MEMORANDUM AND ORDER**

(petitioner) petitions for regrading his answers to questions 20, 33, 34 and 43 of the afternoon section of the Registration Examination held on October 18, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

### **BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 66. On January 30, 2001, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent

Legal Administration.

### **OPINION**

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from

the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions.

Where the terms “USPTO” or “Office” are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for afternoon questions 20, 33, 34 and 43. Petitioner's arguments for these questions are addressed individually below.

Afternoon question 20 reads as follows:

Your client, Bill, disclosed to you the following. While hiking, he found a natural specimen of tree sap that had bonded rock material to a log, and was impervious to water. Bill realized that the sap would be an excellent roofing material for bonding asphalt shingles to wooden sheathing. Bill performed a chemical analysis of the sap and determined it was 10% A, 30% B, and 60% C. Bill experimented and found that he could synthetically produce the sap by mixing one part A by weight and three parts B by weight at 20 degrees Celsius, heating the mixture of A and B to 100 degrees Celsius, adding six parts C by weight, and cooling the mixture of A, B, and C to 20 degrees Celsius. Bill further experimented and found that if he added an effective amount of D to the mixture of A, B, and C, prior to cooling, the viscosity of the product would decrease, making it easier for roofers to apply it to wooden sheathing. You draft a patent application with a specification having all the information disclosed to you by Bill, including guidelines that explained that an effective amount of D for decreasing the viscosity is between 1% to 2% of the total weight of the mixture of A, B, and C, after cooling. The guidelines also explained that an effective amount of D for brightening the color of the composition is between 3% to 4% of the total weight of the mixture of A, B, and C, after cooling.

20. Assuming that A, B, C, and D are known materials, which if any of the following claims, included in Bill's application, would not be properly rejected pursuant to 35 U.S.C. 112, second paragraph?

Claim 1. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; and adding six parts C by weight to the mixture of A and B.

Claim 2. A composition for bonding asphalt shingles to wood sheathing, comprising 10% A, 30% B, and 60% C.

Claim 3. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; adding six parts C by weight to form a mixture of A, B, and C; cooling the mixture of A, B, and C to 20 degrees Celsius; and adding an effective amount of D.

- (A) Claim 1.
- (B) Claim 2.
- (C) Claim 3.
- (D) Claims 1 and 2.
- (E) None of the above.

The model answer is selection D.

Claims 1 and 2 are drawn to a naturally occurring composition but do not provide the basis for a rejection under 35 U.S.C. § 112, second paragraph, even though they do provide the basis for a rejection under 35 U.S.C. § 101. MPEP § 2105. Therefore (A) and (B) are incorrect. Claim 3 is indefinite because it recites an “effective amount” without stating the function to be achieved. MPEP § 2173.05(c). Therefore (C) is incorrect. (E) is incorrect because (D) is correct.

Petitioner argues that answer (B) is correct. Petitioner contends that claim 2 is the only definite claim and that claim 1 fails to define the metes and bounds of the invention. Petitioner argues that claim 1 fails to define the product by process. Petitioner argues that the claim is indefinite because it fails to show the interrelationship of the parts claimed, since it fails to include the cooling step.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that claim 1 is indefinite, claim 1 is definite because it is drawn to a naturally occurring composition. The step for cooling the mixture is a nonessential step. Accordingly, model answer D is correct and petitioner’s answer B is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 33 reads as follows:

33. Mike and Jill are members of the Virginia Bar with a general law practice. Jill is registered to practice before the USPTO and is constantly poking fun at Mike for not being registered. Jake, one of Mike’s former clients, owns a small tool shop and while attempting to remove a broken drill bit from a workpiece, invented a tool that easily extracts a broken bit. The tool is simple to make. Jake asked Mike if he could patent his invention, and Mike, desiring to impress Jill with his patent skills, said, “No problem.” Using a “how to” book that he obtained from the INTERNET, Mike prepared an application on Jake’s invention and filed it in the USPTO together with a power of attorney which Jake executed naming Jack as attorney of record. Shortly thereafter, the Mike and Jill firm hired Jim, a registered patent attorney, and Mike physically filed a document with the USPTO naming Jim as an associate attorney in Jake’s application. Upon reviewing Jake’s application, Jim discovered that the original claims omitted the recitation of a critical element which was disclosed in the specification. Assuming a preliminary amendment is filed with the USPTO adding the critical element to the claims, and explaining in the REMARKS that the critical element was inadvertently omitted at the time of filing the application, which of the following is the most comprehensive

answer in identifying the individual(s), if any, who by signing the amendment will be recognized by the USPTO for representation?

- (A) Jake
- (B) Jim
- (C) Jill
- (D) All of the above
- (E) None of the above

The model answer is selection D.

Jake is the applicant, and Jim and Jill are registered practitioners. “An applicant for patent may file and prosecute his or her own application... .” MPEP § 401. The applicant, Jake, is not required to revoke Mike’s power of attorney because Jack is unregistered, and therefore his appointment is void ab initio. MPEP § 402, Form Paragraph 4.09 (first paragraph). Jim and Jill’s signature constitutes “a representation to the Patent and Trademark Office that...he or she is authorized to represent the particular party in whose behalf he or she acts.” 37 C.F.R. § 1.34. This privilege applies whether or not the registered attorney is of record. 37 C.F.R. § 1.31; MPEP § 402. (A), (B), and (C) are wrong because they do not represent the “most comprehensive” answer. (E) is wrong because it is inconsistent with (D), which is correct.

Petitioner argues that answer (A) is correct. Petitioner contends that Jim and Jill are not correct answers because the PTO may not recognize them as applicant’s representative. Petitioner contends while the PTO will probably recognize Jim and Jill, but it does not have to recognize them. See 37 CFR § 1.34 and MPEP § 402.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that Jim and Jill may not be recognized by the PTO, 37 CFR 1.34 states that a practitioners signature constitutes he or she is authorized to represent the party. Accordingly, model answer D is correct and petitioner’s answer A is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 34 reads as follows:

34. You filed a patent application naming your client, Sam, as the sole inventor without an executed declaration under 37 C.F.R. § 1.63. The USPTO mailed you a Notice to File Missing Parts dated January 3, 2000. The Notice to File Missing Parts set a 2-month period for reply.

Which of the following statements is in accordance with proper USPTO rules and procedure?

I. An appropriate reply by you to the Notice to File Missing Parts is, on August 3, 2000 you file a declaration under 37 C.F.R. § 1.63 executed by Sam, with a petition under 37 C.F.R. § 1.136(a) for an extension of five months, and the fee set forth in 37 C.F.R. § 1.17(a).

II. In no situation can any extension requested by you carry the date on which reply is due to the Notice to File Missing Parts beyond Monday, July 3, 2000.

III. An appropriate reply by you to the Notice to File Missing Parts is, on August 3, 2000 you file a declaration under 37 C.F.R. § 1.63 executed by Sam, with a petition under 37 C.F.R. § 1.136(b).

- (A) I
- (B) II
- (C) III
- (D) I and III
- (E) None of the above.

The model answer is selection A.

MPEP § 710.02(d), last paragraph, and 37 C.F.R. § 1.136(a). (B) is incorrect because a Notice to File Missing Parts of an Application is not identified on the Notice as a statutory period subject to 35 U.S.C. § 133. (C) and (D) are incorrect because the provisions of 37 C.F.R. § 1.136(a) are available. (E) is incorrect because (A) is correct.

Petitioner argues that answer (B) is correct. Petitioner contends that if the failure to meet a time period results in the abandonment of the application, then the time period must be a Statutory Period. Petitioner argues that since the application goes abandoned, that the time period for reply must be a Statutory Time Period for Reply.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the time period must be a statutory period because the application goes abandoned, the 2-month time period for reply to a Notice to File Missing Parts of an Application is not identified on the Notice as a statutory period subject to 35 U.S.C. 133. Thus, extensions of time of up to 5 months under 37 CFR 1.136(a) are permitted. See MPEP § 710.02(d), last paragraph. Accordingly, model answer (A) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this

question is denied.

Afternoon question 43 reads as follows:

43. An article in a popular scientific journal, dated January 13, 1998, fully discloses and teaches how to make a “Smart Shoe” wireless telecommunications device. The article discloses a shoe having a dialer in a rubber sole of the shoe. The article does not teach or suggest using a metallic shoelace as an antenna or for any other purpose. Which of the following claims in an application filed January 20, 1999 is/are anticipated by the journal article, and is/are not likely to be properly rejected under 35 U.S.C. § 112, second paragraph as indefinite?

Claim 1. A telecommunications device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a metallic shoelace.

Claim 2. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and a metallic shoelace.

Claim 3. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a random access memory for storing telephone numbers.

- (A) Claim 1.
- (B) Claim 2.
- (C) Claim 3.
- (D) Claims 1 and 3.
- (E) None of the above.

The model answer is selection D.

MPEP § 2173.05(h). *Ex Parte Cordova*, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) and 35 U.S.C. § 102(b). (B) is incorrect since the article does not disclose a metallic shoelace. Since the “optional” element does not have to be disclosed in a reference for the claim to be anticipated, claims 1 and 3 are each anticipated by the article. Thus, (A), (C), and (E) are incorrect.

Petitioner argues that answer (C) is correct. Petitioner contends that claim 1 is indefinite because there is no relationship between the metallic shoelace and the rest of the claimed invention. Petitioner asserts that a claim that fails to interrelate the essential elements of the invention may be rejected under 35 U.S.C. 112, second paragraph. Here, claim 1 fails to interrelate the metallic shoelace with the rest of the shoe.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that claim 1 is indefinite because it fails to interrelate



*the metallic shoelace and the rest of the claimed invention, since the metallic shoelace is optional, it is a nonessential element of the claim. Accordingly, model answer (D) is correct and petitioner's answer (C) is incorrect.*

*No error in grading has been shown. Petitioner's request for credit on this question is denied.*

**ORDER**

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 66. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above the printed name and title.

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Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy